

Remarks

Claim Rejections – 35 USC § 102

Claims 1, 4-5, 22-23, 26 and 28 were rejected in the OA as being anticipated by Hill. Claims 1 and 26 have been amended to clarify that the groove is formed through the centerline between the two longitudinal sides and the groove continues through the end section. A groove is a long narrow hollow or channel made artificially in a surface (*Webster's Third New International Dictionary, Unabridged*). Respectfully, Hill has no groove and certainly no groove through the centerline between the two longitudinal sides. The curved portion of item “d” is a curve not a groove. Also, the end section in Hill “a” does not taper gradually from the longitudinal sides to a rounded point, as required by amended claims 1 and 26, but rather *expands* to a larger elliptical size (79-84) and Figure 1.

Claims 1 and 26 have also been amended to add the size of the instrument, so that the requirement that the device fit into the body of the bait fish is not a functional requirement but is now replaced with a structural requirement. Hill does not state how large his tool is, but it is presumed to be much larger than a bait fish with its elliptical end which is intended for dockworkers to handle large items such as a bale or the like (75-78). Claim 26 also has the dimensions of the device included.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)

Regarding claim 22, Hill does not disclose a groove at all (see Claim 1).

Claims 4, 5, 22, 23 and 28 depend from claim 1 or 26 and for that reason should be allowed..

Therefore it is respectfully requested that Claims 1, 4,5,22, 23, 26, and 28 be allowed.

Claim Rejections – 35 USC §103

Claims 2, 7 and 29 were rejected under 35 USC 103(a) as unpatentable Hill in view of Olson. Hill is a dockworker's tool for handling bails or the like (75-78) and Olson is a fish scaler. It is respectfully argued that Hill is nonanalogous art from the instant invention (a dockworker's tool vs. a fish entrails remover). Hill is also nonanalogous art from Olson and it would not be obvious to modify a dockworker's tool in view of a fish scaler. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Further, Hill's dockworker tool has four distinct parts, a T- handle "c" (described in Hill as "wood or other suitable material"-page 1, line 41,42 and "wood or the like" page 1, line. 98-99), a stem "d", a plate "a", and pins "b". With regard to claims 2, 7, and 29, Hill, as noted above, taught a wooden handle, even while commenting that the stem "d" could be integral with plate "a" (page 1, line 104-105). A wooden handle is inconsistent with an integral tool (claim 7) because one can't cast wood and steel together, and obviously, also with an all steel tool claims 2 and 29).

Regarding claim 7 further, Hill also specifically calls for the pins to be "absolutely rigid and unyielding" (page 2, line 11). In claim 7, modifying Hill with the stamped out prongs of Olson, as in Olson's integral fish scaler (see Figure 5 and page 2, lines 42- 46), would make Hill unsuitable for its intended purpose, since it is respectfully argued that the stamped out prongs could not be absolutely rigid and unyielding as are Hill's screwed in prongs (Note that Hill uses the words "struck out" rather than "stamped out") and as a result the prongs would not grip a bail evenly as required by Hill (page 2, line 10-17). If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Claims 2, 7, and 29, also depend from claims 1 or 26, and for that reason should be allowed. It is therefore respectfully requested that claims 2, 7, and 29 be allowed.

Claims 3 and 6 were rejected over Hill in view of Finney. Hill is a dockworker's tool for handling bails or the like (lines 75-78) and Finney is a poultry eviscerating tool. It is respectfully argued that Hill is nonanalogous art from the instant invention (a dockworker's tool vs. a fish entrails remover). Hill is also nonanalogous art from Finney and it would not be obvious to modify a dockworker's tool in view of a poultry eviscerating tool. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Also claims 3 and claim 6 depend from claim 1 and for that reason should be allowed. It is respectfully requested that claims 2, 3, 6, 7, and 29 be allowed.

Claim 8 was rejected as obvious under 35 USC § 103 over Hill because "it would have been obvious to one of ordinary skill in the art to take the device of Hill and add the body being the bait fish herring, so as to allow for the body to be prepared for further processing." It is respectfully argued that Hill is nonanalogous art from the instant invention (a dockworker's tool vs. a fish entrails remover) and there is no motivation in the prior art to use a dockworker's tool to eviscerate a bait fish. Also, as mentioned under Claim 1, the dockworker's tool for handling bails is much larger than the bait (a couple of inches wide). Also claim 8 depends from claim 1 and should be for that reason allowed.

Claims 9-12, 14, 16, 19, 24-25 and 27 were rejected as being unpatentable over Finney in view of Hill and Hanechak. It is respectfully argued that Hill is nonanalogous art from the instant invention (a dockworker's tool vs. a fish entrails remover). Hill is also nonanalogous art from Finney (a poultry eviscerating tool) and Hanechak (fish filleting apparatus and method) and it would not be obvious to modify a poultry eviscerating tool in view of a dockworker's tool. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430

(Fed. Cir. 1990). . The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. In *re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992).

Referring to claims 9, 16, and 27, Finney does not disclose inserting an eviscerating tool into a fish body but limits it to various types of poultry and fowl (col. 1, lines 5-6). To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In *re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In *re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Also the OA states that it would have been obvious to one of ordinary skill in the art to take the device of Finney and add at least one tine emanating from a location away from the sides of the instrument if Hill, so as to allow the device to easily penetrate the fish. Respectfully, neither Hill nor Finney have anything at all to do with fish and there is no motivation to modify Finney with an extra tine to easily penetrate the fish except for the applicant's disclosure, which is not prior art. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992).

Also, in Claim 9 the dimensions of the device are included in the claim as amended, to further distinguish from Hill and Finney.

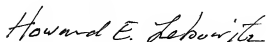
Also, in Claim 27, the dimensions of the device are now present to further distinguish from Finney and Hill.

Referring to claim 24, as previously noted, Hill has curves but no groove. Finney's groove (see Figure 4) is, respectfully, anything but continuously curved, its practically square in cross-section.

Claims 10-12, 13 -21 and 24-25 also depend from claim 9, and should also be allowed for that reason.

Applicant believes that through amendment and argument claims 1-30 are now in condition for allowance, and respectfully requests reconsideration and Notice of Allowance.

Respectfully Submitted,

A handwritten signature in cursive script that reads "Howard E. Lebowitz".

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